

#8

PATENT
Attorney Docket No.: SALK2150-1
(088802-4902)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Doucas *et al.*

Group Art Unit: 1631

Application No.: 09/990,255

Examiner: Unknown

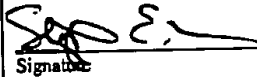
Filing Date: November 20, 2001

CERTIFICATE OF FACSIMILE TRANSMISSION
I hereby certify that this paper is being facsimile transmitted to the United States Patent and Trademark Office, Washington, D.C., on the date below.

For: METHOD FOR THE IDENTIFICATION
AND USE OF SUBSTANCES THAT
MODULATE POD FUNCTION AND/OR
STRUCTURE

Stephen E. Reiter

Name of person mailing paper



September 11, 2003

Signature

Date

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

FAX RECEIVED

SEP 11 2003

REQUEST FOR RECONSIDERATION OF PETITION
UNDER 37 C.F.R. § 1.47(a)

PETITIONS OFFICE

Sir:

Responsive to the Decision Refusing Status under 37 C.F.R. § 1.47(a) (mailed March 11, 2003), Applicants hereby request reconsideration of the petition. This request is timely filed, as it is accompanied by a petition and the appropriate fee to extend the time for response to September 11, 2003 (four-month extension).

Applicants respectfully submit that the initial petition to accept the declaration without the signature of inventor Doucas under 37 C.F.R. § 1.47(a) has been unfairly dismissed in light of the evidence submitted, and only on the basis of formalities. Although the evidence previously submitted reflects papers filed with the parent application (08/975,272), the present application is directly related thereto as a divisional application of the parent application in which inventor Doucas refused to acknowledge the inventive contribution of inventor Trono to

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any part of the invention disclosed therein. The subject matter of the claims in the present divisional application was clearly present in the parent case in which inventor Doucas refuses to acknowledge any inventive contribution of inventor Trono.

With respect to item (1) of the petition requirements, the following evidence is re-submitted as proof that inventor Doucas refuses to sign any papers which would acknowledge any inventive contribution of inventor Trono. Applicants' representative, as well as the Assignee of both applications, The Salk Institute for Biological Studies, attest that inventor Doucas has repeatedly asserted that he has not, and will never agree to sign any formal documents that would also include inventor Trono.

Summary of selected correspondence between Applicants' representatives and Vassilis Doucas

August 31, 2001 - **Initial request** (facsimile to University of Geneva) for new declaration to support change of inventorship.

September 5, 2001 - **Second request** (e-mail)

September 10, 2001 - Response from Dr. Doucas (excerpt of e-mail)

"Inventors in this patent have been established through many many official documents. . . You are asking me now to add another inventor, 6 years later!? Why?!"

September 26, 2001 - **Third request** (facsimile and mail)

October 4, 2001 - Telephone conference with Dr. Doucas (excerpt of memo to file)

"At this point, it is highly unlikely that he would agree to a correction of inventorship. . . He feels that inventorship has been established on several occasions . . ."

October 6, 2001 - E-mail from Dr. Doucas to Dr. Evans (second inventor)

"You certainly know that there is no reason to add Trono or any other person in this patent."

Exactly
as
submitted
with
original
petition

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October 15, 2001 - Response from Dr. Doucas (excerpt of e-mail)

"... I just got the fax of Dr. Reiter dated September 26, 2001. As it was not indicated confidential [sic] these documents "disappeared" for few weeks. The lab is under Dr. Trono and his colleagues inspection! Never the less, I am very surprised with the letter of Dr. Reiter saying that "the majority of the claims require the presence of retroviral proteins...it is our understanding that Dr. Didier Trono, the resident lentiviral expert at the Institute at the time of invention, made significant contribution..." I am sure that Dr. Reiter knows very well that who is inventor is well defined by law. Also he knows very well together with Dr. Evans and all the Salk patent committee, as confirmed in many official doc, that **invention was established by myself... Trono is for nothing in that invention!**"

(emphasis added)

Elaborated
(with
respect to
original
petition)
to place
quoted text
in context
of e-mail

Unfortunately, inventor Doucas is increasingly hostile and uncooperative with every attempt to reach him. The PTO's requirement that inventor Doucas be presented again (in the instant application) with substantially the same papers that he has repeatedly refused to sign in the parent application would be pointless, and unduly inflammatory under the circumstances. The Assignee has done all that it could, and should not be subjected to any additional hardship and expenses that would be incurred if required to once again request the cooperation of inventor Doucas.

With respect to item (4) of the petition requirements, the last known address of non-signing inventor Doucas is as follows:

Vassilis Doucas, 87, rue de Carouge, 1205 Geneva, Switzerland.

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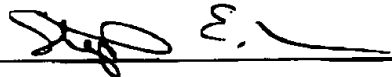
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Applicants respectfully request that this Petition be granted in light of the circumstances and evidence presented to date. In the event any matters remain to be resolved in view of this communication, the Petitions Examiner is encouraged to call the undersigned so that a prompt disposition of this Petition can be achieved. If any additional fee is due, the Commissioner is hereby authorized to charge Deposit Account No. 50-0872.

Respectfully submitted,

Date: September 11, 2003

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